Appl. No. 09/774,439   PATENT
Amdt. dated July 29, 2005
Reply to Office Action of May 20, 2005

REMARKS/ARGUMENTS

Amendments

        The specification is amended to correct the page numbering and several oversights that are grammatical, clerical or typographical in nature. Additionally, the claims are modified in the amendment. More specifically, claims 1, 11 and 17 have been amended; no claims have been cancelled; and no new claims have been added. Therefore, claims 1-20 arc present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §102 Rejection, Donaldson.

        The Office Action has rejected claims 1-9, 11 and 13-16 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,321,267 to Donaldson (hereinafter "Donaldson"). For a valid anticipation rejection, the Office must show that each and every limitation from the claims appears in a single piece of prior art. Applicants believe major limitations from the independent claims 1 and 11 arc neither taught nor suggested in the Donaldson reference. More specifically, Donaldson cannot be relied on to teach or suggest using the routing information to determine the facilitating party. Donaldson may find a facilitating party, but does not use the routing information, as that term is defined by the amended claims.

        Some background on how email is transferred would be helpful in appreciating the claimed differences from Donaldson. When any email message is transferred, several steps happen:

    (1) handshaking prepares both sender and receiver for transmission of the email message (Donaldson, figure 3, "Starting Protocol"),

    (2) the header of the email is transferred (Donaldson, figure 3, "Header"; Specification, figure 4, 404),

      (3) the body of the email is transferred (Donaldson, figure 3, "Body"; Specification,

          figure. 4, 408), and

      (4) handshaking confirms that transmission is complete (Donaldson, figure 3, "Ending

          Protocol").

Appreciation of the differences in the claim with respect to Donaldson requires noting where in this process Donaldson is gathering information.

        Donaldson discloses "Active Filtering" to determine if an email is unsolicited. (Donaldson, col. 8, ll. 7-17). "Active Filtering" involves queries based on the contents of the "MAIL From" field. (Donaldson, col. 15, l. 20 - col. 16, l. 11) This "MAIL From" field is part of what Donaldson refers to as "Starting Protocol." (Donaldson, figure 3). However, Applicants note that even Donaldson acknowledges that this "Starting Protocol" is separate from the message. (Donaldson, col. 4, ll. 1-7) Donaldson teaches conducting "Active Dialup" testing (Donaldson, col. 20, l. 5 - col. 26, l. 11), "Active Relay" testing (Donaldson, col. 26, l. 13 - col. 30, l. 5), and "Active User" testing. (Donaldson, col. 30, l. 7 - col. 31, l. 60) However, each of these tests is conducted during the "Starting Protocol" exchange. (See Donaldson, figure 3, steps 1403 - 1484) Donaldson has completed all of its tests by the time the message header arrives. (Donaldson, figure 13, 1488) In contrast, the present claims require parsing the email message header, specifically the routing information portion of the header. (Claim 1, l. 17, Claim 11, l. 6, Claim 17, l. 20)

        As Donaldson also points out, "Bcc filtering" is a known technique for filtering unsolicited email. (Donaldson, col. 7, ll. 43-45) This technique advocates parsing the recipient information to check for a local domain address. (Donaldson, col. 33, ll. 13-23) However the present claims divide the header into 3 sections: (1) routing information; (2) recipient information; and (3) email address of the sender. (Claim 1, ll. 7-15, Claim 11, ll. 8-15, Claim 17, ll. 12 - 19). The present claims require parsing of routing information, whereas Bcc filtering requires parsing of recipient information. Accordingly, Donaldson's teaching of Bcc filtering

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cannot anticipate the claims because that is based upon recipient information and not routing
information.

Reconsideration of the anticipation rejection is respectfully requested.

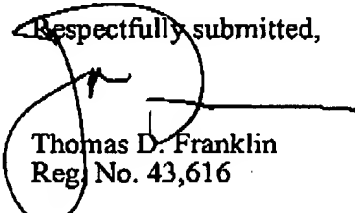### *35 U.S.C. §103 Rejection, Donaldson in view of Pace et al.*

The Office Action has rejected claims 10, 12 and 17-20 under 35 U.S.C. §103(a)
as being unpatentable over the cited portions of Donaldson in view of the cited portions of U.S.
Patent No. 6,460,050 to Pace et al. (hereinafter "Pace"). As noted in the previous section,
reliance on Donaldson for teaching that routing information is used to determine the facilitating
party is not reasonably supported. Claim 17 is believed allowable for at least this reason. The
Applicants further believe that claims 2-10, 12-16 and 18-20 are in condition for allowance by
virtue of their dependence from the allowable independent claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this
Application are in condition for allowance. The issuance of a formal Notice of Allowance at an
early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of
this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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